

DOCKET NO: 245878US0CONT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
HIROSHI MIYAKE, ET AL. :
SERIAL NO: 10/720,021 :
FILED: NOVEMBER 24, 2003 : GROUP ART UNIT: 1624
FOR: AROYL-PIPERAZINE :
DERIVATIVES, THEIR PREPARATION :
AND THEIR USE AS TACHYKININ :
ANTAGONISTS

REQUEST FOR RECONSIDERATION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The present continuation application was filed on November 24, 2003 as a continuation of a continued prosecution application (CPA) filed December 26, 2002, which CPA was filed intentionally without the filing fee. On January 22, 2003, an Office Action was entered even though the filing fee had not been paid. As indicated by the Interview Summary dated February 6, 2003, Supervisory Examiner Richard Raymond vacated the Office Action and indicated that a Notice to File Missing Parts would be mailed. In response to a Notice to File Missing Parts, mailed April 23, 2003, Applicants paid the fee, along with the fee for a five-month extension of time, thus assuring pendency with the present continuation application. On October 12, 2004, the filing fee, required late fee, request for five-month extension of time, with the applicable extension of time fee, were filed. The application is thus now ripe for examination on the merits.

Thus, while the above-discussed Office Action dated January 22, 2003 has been vacated, it is assumed that once the appropriate fees were paid, the Office Action would be made part of the official record. The following response is intended to preempt official entry of the Office Action.

Claims 1-3, 5-6 and 8 have been rejected under 35 U.S.C. § 102(e) as anticipated by U.S. 6,087,357 (Matsuo et al). That rejection is untenable and should not be repeated. Matsuo et al is not available under 35 U.S.C. § 102(e) because its § 102(e) date is June 18, 1998. The filing date of the international application corresponding to the present application is June 15, 1998. Applicants are entitled to this date automatically under 35 U.S.C. § 363. However, as indicated on the face of Matsuo et al, there is a corresponding PCT Publication No. WO97/22597, having a PCT publication date of June 26, 1997. The PCT publication, since it was published less than a year before the filing date herein of June 15, 1998, is available under 35 U.S.C. § 102(a) at best. However, the Australian priority application P07359, filed June 17, 1997, which is already in the English language, supports the presently-claimed subject matter, and thus the present application is entitled to this priority date. Accordingly, the subject matter described in Matsuo et al is not prior art herein.

The Examiner has found that Applicants are not entitled to their Australian priority date due to amendment of the present claims. However, the burden is on the Examiner to show with particularity what specifically-claimed subject matter herein is not supported by the priority application. No such showing has been made. Accordingly, it is respectfully requested that this rejection not be repeated.

Claims 1-6 and 8 were provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over above-discussed Matsuo et al. That rejection should not be repeated. The claims of Matsuo et al require that R⁴ be limited to one of a Markush group of various morpholinyl-containing moieties. The corresponding R⁴ of the present

claims is not so limited. Accordingly, it is respectfully requested that this rejection not be repeated.

Claims 1-3, 5-6 and 8 have been rejected under 35 U.S.C. § 112, second paragraph. The Examiner finds that Applicants are not claiming what they regard as their invention by pointing to the above-discussed Australian priority application, wherein the Examiner finds that Claim 1 therein is defined in a different manner from that recited herein. In reply, 35 U.S.C. § 112, second paragraph, contains no requirement that claims correspond to claims in a priority application. The scope of the present claims is clear and definite, and they constitute what Applicants regard as their invention. Accordingly, it is respectfully requested that this rejection not be repeated.

The Examiner finds that Claim 1 recites different subject matter compared to Claim 1 of the priority application, and that therefore this is new matter. In reply, any issue of new matter must be with respect to the present application *per se*. Since the claims in question are original claims, there can be no question of new matter. Accordingly, the Examiner is respectfully requested to withdraw this finding.

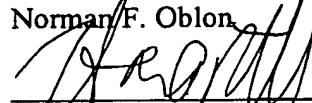
The Examiner finds that the terms "aryl" and "substituted aryl" for the variables R¹ and R² in Claim 1 are indefinite and not acceptable. In reply, should the Examiner find the present application otherwise in condition for allowance, the Examiner is hereby authorized by Examiner's Amendment to replace the term "aryl" with --C₆-C₁₀ aryl--.

The Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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